

REMARKS

Claims 1, 2, 5 through 7, and 10 are pending in this Application. Independent claims 1 and 6 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicant submits that the present Amendment does not generate any new matter issue.

The Drawings.

The Examiner asserted that Figs. 7A and 7B should be designated with a legend "PRIOR ART". In response Figs. 7A and 7B have been amended to provide the legend "PRIOR ART", as suggested by the Examiner, and appear in the attached REPLACEMENT SHEET (EXHIBIT A).

Claims 1, 2, 5 through 7, and 10 were rejected under 35 U.S.C. § 102 for lack of novelty over the acknowledged prior art.

In the statement of the rejection the Examiner referred to paragraph 50, asserting the disclosure of first layer 7b in contact with the light modulating region and second layer 7a. The Examiner broadly interpreted the word "contact" to include thermal and indirect physical contact. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir.

2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a fundamental difference between the claimed semiconductor optical integrated devices and the acknowledged prior art device that scotches the factual determination that the acknowledged prior art device constitutes a description of the identically claimed invention within the meaning of 35 U.S.C. § 102.

Specifically, independent claims 1 and 6 are directed to a semiconductor optical integrated device comprising, *inter alia*, a light-modulating region having a first facet for outputting light generated in the light-generated region and modulated in the light-modulated region, wherein the first facet provides a coating including a first layer **in physical contact** with the light-modulating region, and a second layer which is in physical contact with the first layer but not in physical contact with the first facet. This is not the type of structure which is acknowledged to be prior art. The acknowledged prior art device is **not** a structure wherein the first layer is in physical contact with the light-modulating region, and the second layer is in physical contact with the first layer but not in physical contact with the first facet.

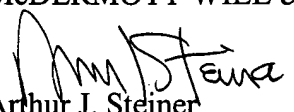
The above argued structural difference between the claimed devices and the acknowledged prior art device undermines the factual determination that the acknowledged prior art device constitutes a description of the identically claimed invention within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claims 1, 2, 5 through 7, and 10 under 35 U.S.C. § 102 for lack of novelty as evidenced by the acknowledged prior art is not factually viable and, hence, solicits withdrawal thereof.

Application No.: 10/797,197

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS

Fig. 7A and 7B have been amended to provide the legend "PRIOR ART" as suggested by

the Examiner and appear in the attached REPLACEMENT SHEET (EXHIBIT A).



EXHIBIT A